

Applicants: Thomas M. Jessell et al.
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REMARKS

Claims 17, 19, 20, 22-27 and 36-48 are pending and under examination in the subject application. Claims 17, 20, 22-27 and 36-40 have been withdrawn by the Examiner. Claims 19, 41 and 42 have been allowed by the Examiner. Applicants have hereinabove cancelled claims 17, 20, 22-27, 36-40 and 43-48 without prejudice. In making these amendments, applicants neither concede the correctness of the Examiner's rejections, nor abandon their right to pursue in a continuing application embodiments of the instant invention no longer claimed in this application. Applicants maintain that these amendments raise no issue of new matter, and respectfully request entry of this Amendment. Upon entry of this Amendment, allowed claims 19, 41 and 42 will be pending.

Formalities

Election/Restriction

The Examiner withdrew claims 17, 20, 22-27 and 36-40 from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. The Examiner stated that applicants timely traversed the restriction (election) requirement. The Examiner stated that applicants' traversal to the restriction requirement and assertion that claims 17, 19, 20, 22-27 and 36-48 define a single invention has been fully considered but is not deemed persuasive.

In response, applicants respectfully traverse. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have hereinabove cancelled claims 17, 20, 22-27 and 36-40 without

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prejudice or disclaimer to their right to pursue these claims in a later-filed application.

Priority

Applicants acknowledge the Examiner's withdrawal of the objection to the specification with respect to the priority paragraph.

Drawings

Applicants acknowledge the Examiner's withdrawal of the objection to the drawings.

Rejection Under 35 U.S.C. §112, first paragraph

The Examiner maintained the rejection of claims 43-48 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner stated that applicants traverse the rejection, and submit that claims 41-48, as amended, address the Examiner's rejection and satisfy the requirements of 35 U.S.C. §112, first paragraph.

The Examiner stated that applicants' amendments have overcome the rejection of claims 41 and 42, since the specification is enabling for the dorsalin-1 polypeptide to stimulate neural crest cell differentiation.

The Examiner stated that, however, applicants' arguments are not deemed persuasive for claims 43-48. The Examiner stated that although the claims no longer recite a "pharmaceutical composition", the claims still encompass a composition comprising an amount of isolated dorsalin-1 polypeptide effective to regenerate a nerve cell, promote bone growth or wound healing or

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inhibit neural tumor cell growth in a subject, and these limitations require enablement of the claimed compound for the recited use. The Examiner stated that the specification is not enabling for such uses of the dorsalin-1 composition, as discussed in the previous Office Action. Therefore, the Examiner stated that the rejection is maintained.

In response, applicants respectfully traverse. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have hereinabove cancelled claims 43-48 without prejudice or disclaimer to their right to pursue these claims in a later-filed application. Applicants contend that this amendment renders the above rejection moot.

Summary

In view of the amendments and remarks made herein, applicants note that allowed claims 19, 41 and 42 are the only claims pending in this application. Accordingly, issuance of a Notice of Allowance is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

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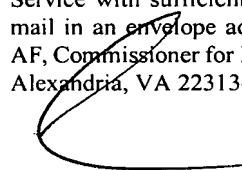
No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Alan J. Morrison
Reg. No. 37,399

Date

6/28/04